

Remarks

Claims 1-5 and 7-18 and 20-23 are currently pending in the application. Claims 2, 11, 12 and 23 have been amended in this paper. Claims 22 has been cancelled without prejudice.

Claim rejections – 35 USC § 112

Claim 23 was rejected under in 35 USC § 112 because of the term “a clip having”. In accordance with the Examiner’s helpful suggestion this term has been deleted, and we submit that the rejection can now be withdrawn.

Claim rejections – 35 USC § 103

Rejection of claims 1-5, 7-16 and 18 under 35 USC § 103 in view of Yeager and Nadeau

Claims 1-5, 7-16 and 18 were rejected on the basis of 35 USC § 103 as being obvious in view of the primary reference of Yeager (which does not disclose the claimed feature of the attachment members) when combined with the secondary reference of Nadeau (which according to the Examiner discloses the equivalence of handles and attachment members). The examiner has indicated that Yeager would be modified in view of Nadeau to include an attachment device such as a harness, a releasable attachment or a pivotable attachment.

In connection with claim 1, Applicant contends that even if Nadeau discloses the equivalence of handles and harnesses, Yeager is fundamentally incompatible with the modification to include a harness, and is therefore not compatible with Nadeau. This prejudice in Yeager is absolutely fundamental and consistent from the very beginning of the document, and would be clearly understood by a skilled reader as teaching away from the combination suggested by the Examiner. Note that Yeager states in the first few lines (Column 1, lines 19-38) that

...Traditionally, the approach to managing the problem has focused on hardware-based methods and materials. Attempts to control children have involved the use of tethers, buckles, rings and poles. These items have been arranged in a manner to impart directional control through harnesses or safety line systems, e.g. as described in U.S. Pat. No. 4,563,981. Although these measures exist, they are not fully utilized by the populations they are intended to serve. There are many reasons for this lack of use. For example, the nature of such devices can contribute to injuries related to entanglement, pinching, pulling, jarring and tripping. Further, the appearance or mechanics of such devices tends to be perceived as leash-like as in controlling animals. Additionally known devices have been complex, often requiring technically or physically cumbersome set-up or operation. Such known devices may also readily malfunction or become misplaced. As a further disadvantage, small children often do not initially cooperate with a foreign-looking apparatus....

...and in line 53-54 Yeager specifically states that

...Unlike the prior art, the group walking toy does not employ tethers, rings, buckles or coils as in harnesses or safety line systems. (Emphasis added)

It is respectfully submitted that these passages alone in Yeager would immediately dissuade any reasonable skilled person from adopting any kind of tether or harness or anything that permanently attached the user to the spine member, as this would be entirely inconsistent with the plain and strong message the Yeager itself that whatever else might be modified about the Yeager device, it would be completely against the teaching in Yeager to put a harness or other permanent attachment device onto the Yeager toy.

The Federal Circuit has repeatedly stated that teaching away from an element of the invention is a *per se* demonstration of the lack of prima facie obviousness. See, for example, *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed.Cir. 1988); *In re Fine*, 837 F.2d

1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed.Cir. 1987).

However, as additional evidence in support of the Applicant's contention in this regard, we attach a Declaration from Peter Ford, an expert toy designer from DeMontford University in the UK. As noted in the attached Declaration, Mr. Ford's expertise permits him to offer valuable testimony in the field of toy design related to the claimed invention. Mr. Ford's Declaration attests to the facts that because Yeager is so vehemently opposed to having any kind of tether arrangement, he as a skilled person, when tasked with the modification and improvement of the Yeager device, would not modify the Yeager device to have any kind of tether arrangement, taken from Nadeau, Gandelman, or anywhere else. This independent evidence from Mr. Ford as a respected and qualified designer of toys and safety products establishes that even if Nadeau was read in combination with Yeager, and the skilled person was tempted to incorporate the tether arrangement of Nadeau, the modification underpinning the Examiner's objection combining Yeager and Nadeau would not be made, because Yeager plainly opposes any kind of tether.

It is well settled that objective evidence of non-obviousness must be considered when determining patentability. And the Federal Circuit has held that the testimony of individuals skilled in the art is entitled to substantial weight. *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 217 U.S.P.Q. 193 (Fed. Cir. 1983). As stated in the MPEP 716.01(d), "Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself." (Citing *In re Eli Lilly*, 902 F.2d 943 (Fed. Cir. 1990.)) All the evidence in the Declaration must be considered as a whole and contrasted against what is taught by the cited references individually. Thus, the Declaration of Mr. Ford must be considered and given substantial weight when assessing the nonobviousness of the invention. Further, the courts have repeatedly stated that an Examiner cannot rely on personal knowledge to overcome evidence from experts absent factual support.

In view of the strong and consistent teaching away from the combination of Yeager with

any kind of harness device, we respectfully traverse the Examiner's rejection of claim 1. Since the remaining claims 2-5, 7-16 and 18 are dependent on claim 1 and include the limitation of the attachment members by virtue of this dependency, they are also allowable for the same reasons.

Claim 2 is allowable for additional reasons. Claim 2 has now been amended to further distinguish the invention claimed from Yeager. In amended claim 2, the additional limitation appears that the attachment members extend from each side of the spine member. This limitation is found nowhere in either of Yeager or Nadeau. Yeager exclusively teaches that the compartments for accommodating users extend from one single side of the spine. All of the embodiments of Yeager adhere to this strict regime. The reason for this is that if the compartments were provided on both sides, then the Yeager device would lose its visual appeal as a toy because, for example, the shark tail would not be evident to the children. The visual appeal of the Yeager device is a crucial and significant feature of the Yeager system as taught in column 1 lines 20-48, and as attested to by Ford's declaration. Also, if the "each side" arrangement of the compartments were to be adopted in the Yeager system it would be cumbersome wide and might not fit through doorways. This would, thus, teach against such a modification of Yeager. The missing "each side" feature of the present invention is not found in Nero either, so even if the two references were to be combined, the claimed combination of features could not be found in the two documents. It is respectfully submitted that claim 2 is therefore allowable.

Claim 11 has also been amended to distinguish it further from the cited art, and now contains additional detail relating to the pivot. The Examiner rejected previous claim 11 on the basis that the lateral extensions of the Yeager device "would be pivotable to a degree". Applicant does not agree that this is derivable from Yeager, because as the Mr. Ford establishes in his Declaration, it is not possible to determine the extent of flexibility of the Yeager device. In any event, the point is moot because the amended claim 11 states that the arms are pivotally attached to the spine member, which requires more than an accidental flexibility as the Examiner has mentioned, but rather requires (in this claim) a specific provision in the attachment mechanism to allow an intentional movement between the arm and the spine member.

Accordingly, it is respectfully submitted that the rejection is traversed.

Rejection of claim 17 under 35 USC § 103 in view of Yeager, Nadeau and Nero

Claim 17 is dependent on claim 1, and includes all of the features of claim 1, including the releasable fastener device. As argued above, claim 1 is allowable over the prior art of record, and accordingly the Applicant submits that this dependent claim is therefore also allowable, for the same reasons. Accordingly the rejection on the basis of this combination (or any combination based on Yeager) is not sustainable and is most respectfully traversed.

Rejection of claims 20-23 under 35 USC § 103 in view of Yeager, Nadeau and Gandelman

Rejection of these claims is respectfully traversed. As argued above, Yeager and Nadeau would not be combined, and even if they were, the resultant combination would not include the attachment device of either Nadeau or Gandelman, because the Yeager device is so fundamentally opposed to any kind of tether, as attested to by the independent expert toy designer Mr. Ford. The whole purpose of the Yeager patent is to distinguish itself from the earlier prior art mentioned in its introduction, which was reliant on harnesses, to adopt a different approach of attracting the children by the visual impact of the Yeager device, and to entice them to remain close to the Yeager spine not by any kind of harness or attachment, but by voluntary cooperation and the provision of an interesting and fun toy. In essence the Yeager device attracts rather than restrains the children, and would not be modified to include any kind of buckle or harness, from Nadeau, Gandelman, or elsewhere.

Further Evidence of Non-obviousness

As additional evidence of the surprising nature of the present invention, Applicant submits a second declaration from the inventor, Elaine Stephen, which attests to the unsolicited prizes awarded to the presently claimed invention. The list of exhibits includes various press articles attesting to the commercial success and desirability of embodiments of the present

invention.

The awards referred to in Ms. Stephen's Declaration are clear and unbiased evidence of non-obviousness. The awards illustrate the commercial success that the product has achieved, not in monetary terms, but in accolades and commendations. These awards highlight the non-obviousness of the invention to the skilled people in the industry. To win one award or receive one accolade would be sufficient proof that the invention was well received in the industry. But to achieve the sheer volume of awards is monumental.

This is clear evidence supporting the non-obviousness of the invention in the field and must be considered in determining the appropriateness of the current rejection. MPEP 716.01(B). *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). In *In Re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007) (copy enclosed) decided on August 29, 2007, the Federal Circuit vacated a decision by the Board of Appeals which rejected claims in an application because of the Board's error in not considering three declarations submitted in the application. The Federal Circuit held that the "Board improperly failed to consider the rebuttal evidence" provided in the declarations. The Federal Circuit went on to state,

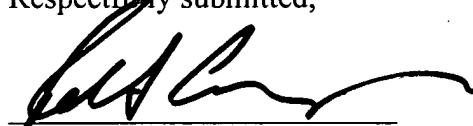
"It is well settled that the PTO bears the initial burden of presenting a prima facie case of unpatentability.... However, when a prima facie case is made the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Rebuttal evidence is merely a showing of facts supporting the opposite conclusion.... When a patent applicant puts forth rebuttal evidence, the Board must consider that evidence."

Id., at pages 8-9 (internal citations omitted). The Court stated that the Board had failed to give *meaningful consideration* to the submitted declarations. The Court also noted that the Board's explanation of the declarations was too narrow and did not properly appreciate the evidence that was presented in the declaration to address unexpected results, teaching away, long felt need. Thus, the Declarations submitted in this case must be given appropriate weight when reconsidering the current rejections.

It is respectfully submitted that all pending claims are in condition for allowance, and Applicant respectfully requests that allowance be granted at the earliest date possible. Should the Examiner have any questions or comments regarding Applicant's amendments or response, the Examiner is asked to contact Applicant's undersigned representative at (215) 988.3303.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to our Deposit Account No. 50-0573.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert E. Cannuscio', is written over a horizontal line.

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